

REMARKS

Reconsideration and withdrawal of the restriction requirement and election of species are respectfully requested in view of the remarks herein.

The May 22, 2006 Office Action required restriction from among:

- Group I. Claims 20-27, 29 and 30, drawn to GM-CSF protein and pharmaceutical composition, classified in class 530, subclass 351 for example.
- Group II. Claims 28-31 as they are drawn to a vaccine comprising GM-CSF and a pathogen, classified in class 424, subclass 184.1
- Group III. Claims 28-31 as they are drawn to a vaccine comprising GM-CSF and a nucleic acid, classified in class 514, subclass 44.
- Group IV. Claims 32-43, drawn to a pharmaceutical composition comprising GM-CSF-encoding nucleic acids, classified in class 514, subclass 44.

Group I is elected, with traverse, for further prosecution in this application. Applicants reserve the right to file divisional applications to non-elected subject matter. Reconsideration and withdrawal of the restriction requirement are respectfully requested in view of the remarks herewith.

As a traverse, it is noted that the MPEP lists two criteria for a proper restriction requirement. First, the inventions must be independent or distinct. MPEP § 803. Second, searching the additional inventions must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application “[i]f the search and examination of an entire application can be made without serious burden, ...even though it includes claims to distinct or independent inventions.” *Id.*

Groups I, II, III and IV are directed to equine GM-CSF. It is respectfully submitted that any search for the GM-CSF of the Group I claims will certainly encompass references for the vaccine of the Group II and Group III claims as well as the nucleic acid encoding the equine GM-CSF of the Group IV claims. The four groups are inextricably linked in that all four groups encompass equine GM-CSF. Therefore, it is respectfully submitted that it would not place an unnecessary burden on the Examiner to search and examine all four groups together, as a search for the Group I compositions would necessarily include the compositions of Groups II, III and IV.

In the alternative, Groups I and II are directed to equine GM-CSF proteins. It is respectfully submitted that any search for the GM-CSF pharmaceutical composition of the Group I claims will certainly encompass references for the vaccines of the Group II claims. The two groups are inextricably linked in that both groups encompass equine GM-CSF proteins. Therefore, it is respectfully submitted that it would not place an unnecessary burden on the Examiner to search and examine Groups I and II together, as a search for the Group I compositions would necessarily include the composition of Group II.

In another alternative, Groups III and IV are directed to compositions comprising nucleic acids. It is respectfully submitted that any search for the vaccine comprising GM-CSF and a nucleic acid of the Group III claims will certainly encompass references for the pharmaceutical compositions of the Group IV claims. The two groups are inextricably linked in that both groups encompass nucleic acids. Furthermore, Groups III and IV are both classified in class 514, subclass 44. Therefore, it is respectfully submitted that it would not place an unnecessary burden on the Examiner to search and examine Groups III and IV together, as a search for the Group III compositions would necessarily include the composition of Group IV.

In view of the above, reconsideration and withdrawal of the restriction requirement is respectfully requested.

In summary, enforcing the present restriction requirement would result in inefficiencies and unnecessary expenditures by both the Applicants and the PTO, as well as extreme prejudice to Applicants (particularly in view of GATT, whereby a shortened patent term may result in any divisional applications filed). Restriction has not been shown to be proper, especially since it has been shown that the requisite showing of serious burden has not been made. Indeed, the search and examination of each Group would be likely to be co-extensive and, in any event, would involve such interrelated art that the search and examination of the entire application can be made without undue burden on the Examiner, especially as the claims of all Groups have identical classifications. All of the preceding, therefore, mitigate against restriction.

Consequently, reconsideration and withdrawal of the restriction requirement are respectfully requested.

CONCLUSION

In view of the remarks herein, reconsideration and withdrawal of the restriction requirement are requested.

Early and favorable consideration of the application on the merits, and early Allowance of the application are earnestly solicited.

Respectfully submitted,
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